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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,284	12/11/2001	William R. Matz	00883DIV	4382
26285	7590	11/19/2003	EXAMINER	
KIRKPATRICK & LOCKHART LLP 535 SMITHFIELD STREET PITTSBURGH, PA 15222			TRINH, MINH N	
		ART UNIT		PAPER NUMBER
		3729		
DATE MAILED: 11/19/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/014,284	MATZ ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Minh Trinh	3729

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 30 June 2003.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-15 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \*    c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
  - a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2-5.
- 4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Specification***

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The following title is suggested: A method for Aligning an Antenna with a Satellite.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not known how "operating the set box and television" would result in a series of tones are emitted from the television speaker and what signal is the proper indication of the antenna is being aligned with the satellite. Note: it appears that there is no link between the satellite and the operating step. In fact, for the top box to provide a series tones of signals it must received a signal from the associated satellite, tuning, determining and finalizing those signal before accepting them in prior to the emitting and indication of the proper aligning signal. For reasons above, applicants should referred to page 9 of their specification which describes how the operation of the top box being received signal from the satellite and how the signal is being tune or predetermine in

order to provide a proper aligning method. The subject matter as described above should be introduced into the claims in order to clarify the claim languages.

Claim 1, line 4, provides of a generic terminology for the term "LNBF", for example: "low noise block amplifier with an integrated feed" is suggested.

It is not clear whether "said supporting a speaker" (claim 10, lines 1-2) is directed to claim 1, line 7, and if the limitation recites: "a speaker" is same as a speaker recited in claim 1, line 7.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A *terminal disclaimer* signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-15 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-15 of copending Application No. 09/751,277 (hereinafter The '277). This is a provisional double patenting rejection since the conflicting claims have not yet been patented. The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent

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granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

The Application '277 claims the method for aligning an antenna with a satellite of the present application including the steps of: electronically coupling a set top box to a television speaker; coupling the feed/LNBF assembly of the antenna to the set top box; operating the set box and television such that a series tones are emitted from the television speaker which is indicative of the alignment of the antenna with the satellite; supporting a speaker adjacent to the antenna and supporting a transmitter adjacent to the television speaker, the transmitter transmitting the series of tones emitted by the television speaker to the speaker (compare claim 1 of the '277 application).

Limitations of claims 2-4 (see claims 3-5 of the '277 application).

As applied to claim 5, the '277 claims the limitation of claim 5 (see claim 6 of the '277 application).

As applied to claims 6-9, the '277 claims the limitations recited in these claims (see claims 6-10 of the '277 application).

Limitation of claim 13 is also claimed by the '277 (see claim 6 of the '277 application).

Regarding claims 10-12, the '277 does not claim a person associated with the supporting of the speaker. However, It would have been an obvious to have a technician involving in the process especially to provide a speaker supporting means (i.e., supporting the speaker on a person located adjacent to the antenna and these similar to the limitations of the above claims) since applicant has not disclosed that

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these features are critical, patentably distinguishing features and it appears that the invention would perform equally well with the teaching as claimed by the application (see claims 4-5 of the '277 application).

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application (see Application 09/751,277).

### ***Prior Art References***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Prior art references are cited for their teaching of a method for aligning of an antenna with a satellite.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Trinh whose telephone number is (703) 305-2887. The examiner can normally be reached on Monday -Thursday 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (703) 308-1789. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7307.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



Examiner Group 3729

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